

The New Case

In *KSR*, the Court rejected a “rigid” application of the “teaching, suggestion or motivation” (TSM) test. *KSR*, at 11. The Court indicated that a “predictable variation” of the prior art or an improvement which is no “more than the predictable use of prior art elements according to their established functions” is suspect under §103. *KSR*, at 13.

However, though it criticized undue limitation of the obviousness inquiry, the *KSR* Court – citing *U.S. v. Adams*, 383 U.S. 39 (1966) – re-affirmed the doctrine that, when the prior art teaches away from the invention as claimed, when the invention’s elements work together in an “unexpected and fruitful manner”, the invention would not have been obvious. *KSR*, at 12. The Court further observed that “As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, at 14. These principles warrant withdrawal of the pending §103 rejections, as follows.

§ 103 Rejections

It is clear that the invention as claimed is not simply a combination of known elements performing their known functions to give a predictable result. Rather, a surprising result is prescribed in the claims, and thus the claimed invention would not have been obvious.

Chang et al. alone – The rejection is unjustified because applicants’ invention as claimed requires a result which would have been unexpected in view of Chang et al. For the reasons discussed at pages 8-11 of the April 26 Submission, Chang et al. discloses (1) a copolymer different from that defined in applicants’ claims, and (2) that such copolymer has a potent thickening capability which is conceptually the opposite of applicants’ claimed viscosity stabilization (i.e., deliberate viscosity change versus deliberate mitigation of viscosity change).

Thus, Chang et al. “teaches away”, and applicants’ invention as claimed would have been “unexpected”. Under *KSR*, the invention would not have been obvious.

Chang et al. in view of Carpenter et al. – As pointed out in the paragraph bridging pages 11 – 12 of the April 26 Submission, Carpenter et al. does not teach applicants’ copolymer surfactant, or a colorant composition containing same, or the claimed viscosity stabilization. Consequently, the Carpenter et al. teachings would not have allowed one of ordinary skill to predict the claimed viscosity stabilization; they fail to remedy the deficiencies of Chang et al. Accordingly, the combination of Carpenter et al. with Chang et al. “teaches away”, applicants’ invention as claimed would have been “unexpected”, and under *KSR* the invention would not have been obvious.

Chang et al. in view of Robinson – Also as discussed in the paragraph bridging pages 11 – 12 of the April 26 Submission, Robinson does not in any way disclose viscosity stabilization. Although Robinson discloses a polymeric thickener as does Chang et al. – and therefore one of ordinary skill would have known that copolymers within the language of applicants’ claims do have thickening capability (as the Examiner observed in the Office Action dated December 26, 2006, Robinson discloses “tritylphenylpoly(ethyleneoxy) methylacrylate” in a surfactant copolymer) – this would not have revealed applicants’ invention. Again, Robinson is devoid of any mention of viscosity stabilization. Therefore, even the combination of Robinson with Chang et al. would not have foreshadowed applicants’ claimed viscosity stabilization. Rather, based on the combined disclosures of Chang et al. and Robinson, one of ordinary skill would have predicted a powerful thickening action. This constitutes a “teaching away”, and accordingly the invention as claimed would have been unexpected. Under *KSR*, obviousness is foreclosed.

By way of illustration, the Examiner's attention is invited to Example 14 of the instant application. There it is shown that the Stormer viscosity of a latex paint made with a colorant composition according to applicant's invention was little changed from the viscosity of the precursor tint base. In contrast, the Stormer viscosity of a latex paint made with a colorant containing as surfactant primarily isopropyl amine dodecyl benzene sulfonate (an agent not within the copolymer surfactants defined in applicant's claim language) was unfavorably decreased vis-à-vis the Stormer viscosity of its precursor tint base.

Therefore, reconsideration and withdrawal of the §103 rejections are requested.

Related Applications

This opportunity is taken to identify two continuations-in-part of the instant application, namely, Serial No. 11/319,840 filed December 28, 2005, entitled "COPOLYMER SURFACTANTS" (the "840 Application"), and Serial No. 11/913,131 filed July 29, 2005, entitled "LATEX PAINT FILM RESISTANT TO ADVERSE EFFECTS OF WATER, AND COMPOSITIONS AND METHODS FOR MAKING SAME" (the "131 Application").

In the 840 Application, Examples 16-17 have been included to set forth the results of comparative testing of paints made, respectively, with (a) colorant composition comprising a desirable amount of copolymer surfactant formed (inter alia) of the surfactant monomer tristyrylphenylpoly(ethyleneoxy) methylacrylate, and (b) various colorant compositions containing HASE thickener TT-935 (commercially available from Rohm and Haas). (Copies of the pages on which those examples appear are enclosed.) In Example 16, colorant composition (a) had good flow properties, whereas with colorant composition (b) containing TT-935 there was gelling of the colorant composition itself. While with a lesser amount of TT-935 gelling was avoided, it is reported in Example 17 that this resulted in a paint which exhibited less

favorable color development than a paint made with the aforementioned colorant composition (a).

Colorant composition (a), comprising tristyrylphenylpoly(ethyleneoxy) methylacrylate, falls within applicants' claimed invention, and indeed within the scope of not only claim 58 but also specific independent claim 77. Although applicants do not know with certainty, the undersigned is informed they think colorant composition (b) also falls within the bounds of claim 58 (albeit not claim 77) because in TT-935 the surfactant monomer is an acrylic or methacrylic ester moiety joined to a hydrophobic moiety by a poly(ethyleneoxy) chain. The undersigned is further informed that applicants believe colorant composition containing TT-935 has the ability to mitigate viscosity change in a latex paint vis-à-vis the paint's precursor tint base. Thus, Examples 16 and 17 show that, within the scope of the broader invention, various colorant compositions comprising different copolymer surfactants are of varying efficacy. More specifically, it is shown that a colorant composition falling within claim 77 gave surprisingly favorable color development (and permits use of a great amount of copolymer surfactant, without gelling problems, than would have been thought tolerable) even in comparison to another embodiment of the invention falling within broad claim 58 but not claim 77.

Interestingly in U.S. Patent No 6,337,366 (of record), a comparative test reported in Example 5a indicates that when TT-935 was incorporated in a tint base to which a conventional colorant was added, mid-shear viscosity of the tint base plus colorant decreased substantially vis-à-vis the tint base (see Fig. 1). The undersigned is informed that applicants believe an important feature of their claimed invention is incorporating the copolymer surfactant in the colorant composition *per se* rather than the tint base, and that this explains why TT-935 is believed to have viscosity stabilization capability when in a colorant composition but not in the tint base

component. Applicants theorize: When TT-935 is in the tint base, and a conventional colorant which probably contains multiple surfactants is added, the TT-935 in the tint base interacts to some extent with those surfactants, thus diminishing its viscosity stabilizing effect. But, when TT-935 is in the colorant composition, some or all of the other surfactants are replaced by it, which permits viscosity stabilization (but could also be the reason why color development is, per Example 17 of the 840 Application, less efficacious with TT-935).

The 131 Application relates (among other things) to a colorant composition which contains an amount of hydrophobic latex, which latex is not in most instances, but can in some embodiments be, a film-forming latex present in an amount sufficient for a suitable paint film (see page 9 of the application). To the extent they could be construed to constitute paint, such embodiments would of course be excluded by the claim language of the instant application, which explicitly prescribes that the “colorant composition is not itself an aqueous latex paint”. The insertion of that prescription into the claim language by amendment was required by the Examiner; she did not credit the argument (in the Submission filed May 2, 2006) that “colorant composition” excludes aqueous latex paint or “there would be an overabundance of latex upon combination with the tint-base [were the colorant composition to contain a sufficient amount of latex to form the film]” (page 13).

Other References

Additionally, applicants note U.S. Patent Nos. 6,762,269 and 7,217,443, which contain some information about TT-935. These are identified in an accompanying Information Disclosure Statement.

Further, the results of a search in the corresponding European Patent Office case (Application No. 04780973.6) are similarly being made of record in such Information Disclosure Statement.

* * *

In view of the foregoing, allowance of the application is solicited.

Respectfully submitted,

Dated: June 1, 2007

By: /George B. Snyder/
George B. Snyder, Reg. No. 27,675
KRAMER LEVIN NAFTALIS & FRANKEL LLP
1177 Avenue of the Americas
New York, New York 10036
(212) 715-9100 (telephone)
(212) 715-8000 (facsimile)
Attorneys for Applicants